

REMARKS

Claims 1 through 9 are pending in this Application, of which claims 3 through 9 stand withdrawn from consideration pursuant to the provisions of 37 C.F.R. § 1.142(b). Accordingly, claims 1 and 2 are active.

Claim 1 has been amended. Care has been exercised to avoid the introduction of new matter. Indeed, adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure. Applicant submits that the present Amendment does not generate any new matter issue.

The Title

The Examiner asserted that the title is not descriptive and requested a new title. In response the title has been amended, consistent with the Examiner's request.

Claim 1 was rejected under 35 U.S.C. § 102 for lack of novelty as evidenced by Mathews et al.

In the statement of the rejection the Examiner referred to Figs. 1 and 2 of Mathews et al., and to columns 3 through 6 thereof, asserting the disclosure of a semiconductor device corresponding to that claimed. This rejection is traversed.

The factual determination of lack of novelty under 35 U.S.C. § 102 requires the identical disclosure in a single reference of each element of a claimed invention, such that the identically claimed invention is placed into the recognized possession of one having ordinary skill in the art. *Dayco Prods., Inc. v. Total Containment, Inc.*, 329 F.3d 1358, 66 USPQ2d 1801 (Fed. Cir.

2003); *Crown Operations International Ltd. v. Solutia Inc.*, 289 F.3d 1367, 62 USPQ2d 1917 (Fed. Cir. 2002). There is a significant difference between the claimed semiconductor device and the device disclosed by Mathews et al. that scotches the factual determination that Mathews et al. disclose a semiconductor device identically corresponding to that claimed.

Specifically, in accordance with the claimed invention, the packaging layer and the shielding film are in contact with each other. Not so in the device disclosed by Mathews et al. wherein, as apparent from Figs. 1 and 2, the Figs. relied upon by the Examiner, there is a gap between the packaging layer and the shielding film. Thus, there is a significant structural difference between the claimed device and the device disclosed by Mathews et al. But there are more differences.

Further, in accordance with the claimed invention, the shielding film and the packaging layer are formed of materials that exhibit a similar coefficient of linear expansion. This requirement is functionally insignificant because, by selecting the shielding film and packaging layer such that they have similar heat characteristics which approximate each other, warpage and/or peeling are prevented.

The above argued functionally significant structural differences between the claimed semiconductor device and the device disclosed by Mathews et al. undermine the factual determination that Mathews et al. disclose a semiconductor device identically corresponding to that claimed. *Minnesota Mining & Manufacturing Co. v. Johnson & Johnson Orthopaedics Inc.*, 976 F.2d 1559, 24 USPQ2d 1321 (Fed. Cir. 1992); *Kloster Speedsteel AB v. Crucible Inc.*, 793 F.2d 1565, 230 USPQ 81 (Fed. Cir. 1986). Applicant, therefore, submits that the imposed rejection of claim 1 under 35 U.S.C. § 102 for lack of novelty as evidenced by Mathews et al. is not factually viable and, hence, solicits withdrawal thereof.

Claim 2 was rejected under 35 U.S.C. § 103 for obviousness predicated upon Mathews et al. in view of Satoh et al.

This rejection is traversed. Specifically, claim 2 depends from claim 1. Applicant incorporates herein the arguments previously advanced in traversing the imposed rejection of claim 1 under 35 U.S.C. § 103 for lack of novelty as evidenced by Mathews et al. The secondary reference to Satoh et al. does not cure the previously argued deficiencies of Mathews et al. Accordingly, even if the applied references are combined as suggested by the Examiner, and Applicant does not agree that the requisite fact-based motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044, 5 USPQ2d 1434 (Fed. Cir. 1988).

Applicant, therefore, submits that the imposed rejection of claim 2 under 35 U.S.C. § 103 for obviousness predicated upon Mathews et al. in view of Satoh et al. is not factually or legally viable and, hence, solicits withdrawal thereof.

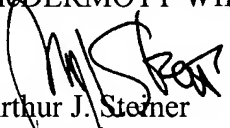
Based upon the foregoing it should be apparent that the imposed rejections have been overcome and that all active claims are in condition for immediate allowance. Favorable consideration is, therefore, solicited.

Application No.: 10/784,268

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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